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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/662,340	09/16/2003	Junji Kobayashi	H64-154706M/MNN	9314
21254	7590	12/06/2005	EXAMINER	
MCGINN INTELLECTUAL PROPERTY LAW GROUP, PLLC 8321 OLD COURTHOUSE ROAD SUITE 200 VIENNA, VA 22182-3817			DOTE, JANIS L	
			ART UNIT	PAPER NUMBER
			1756	

DATE MAILED: 12/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/662,340

Applicant(s)

KOBAYASHI ET AL.

Examiner

Janis L. Dote

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 10 November 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 4 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☒ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: see the attached, paragraph 1. (See 37 CFR 1.116 and 41.33(a)).

4. ☒ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1-15, 18 and 19.
Claim(s) withdrawn from consideration: 16 and 17.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: see the attached paragraph 3.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____.
13. ☐ Other: _____.

Janis L. Dote
JANIS L. DOTE
PRIMARY EXAMINER
GROUP 1533
1700

**Notice of Non-Compliant
Amendment (37 CFR 1.121)**

Application No.

10/662,340

Examiner

Janis L. Dote

Applicant(s)

KOBAYASHI ET AL.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

The amendment document filed on 10 November 2005 is considered non-compliant because it has failed to meet the requirements of 37 CFR 1.121. In order for the amendment document to be compliant, correction of the following item(s) is required.

THE FOLLOWING MARKED (X) ITEM(S) CAUSE THE AMENDMENT DOCUMENT TO BE NON-COMPLIANT:

- ☒ 1. Amendments to the specification:
- ☐ A. Amended paragraph(s) do not include markings.
 - ☐ B. New paragraph(s) should not be underlined.
 - ☒ C. Other see the attached, paragraph 2.
- ☐ 2. Abstract:
- ☐ A. Not presented on a separate sheet. 37 CFR 1.72.
 - ☐ B. Other _____.
- ☐ 3. Amendments to the drawings:
- ☐ A. The drawings are not properly identified in the top margin as "Replacement Sheet," "New Sheet," or "Annotated Sheet" as required by 37 CFR 1.121(d).
 - ☐ B. The practice of submitting proposed drawing correction has been eliminated. Replacement drawings showing amended figures, without markings, in compliance with 37 CFR 1.84 are required.
 - ☐ C. Other _____.
- ☐ 4. Amendments to the claims:
- ☐ A. A complete listing of all of the claims is not present.
 - ☐ B. The listing of claims does not include the text of all pending claims (including withdrawn claims)
 - ☐ C. Each claim has not been provided with the proper status identifier, and as such, the individual status of each claim cannot be identified. Note: the status of every claim must be indicated after its claim number by using one of the following status identifiers: (Original), (Currently amended), (Canceled), (Previously presented), (New), (Not entered), (Withdrawn) and (Withdrawn-currently amended).
 - ☐ D. The claims of this amendment paper have not been presented in ascending numerical order.
 - ☐ E. Other: _____.

For further explanation of the amendment format required by 37 CFR 1.121, see MPEP § 714 and the USPTO website at <http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/officeflyer.pdf>.

TIME PERIODS FOR FILING A REPLY TO THIS NOTICE:

1. Applicant is given **no new time period** if the non-compliant amendment is an after-final amendment or an amendment filed after allowance. If applicant wishes to resubmit the non-compliant after-final amendment with corrections, the **entire corrected amendment** must be resubmitted within the time period set forth in the final Office action.
2. Applicant is given **one month**, or thirty (30) days, whichever is longer, from the mail date of this notice to supply the **corrected section** of the non-compliant amendment in compliance with 37 CFR 1.121, if the non-compliant amendment is one of the following: a preliminary amendment, a non-final amendment (including a submission for a request for continued examination (RCE) under 37 CFR 1.114), a supplemental amendment filed within a suspension period under 37 CFR 1.103(a) or (c), and an amendment filed in response to a *Quayle* action.

Extensions of time are available under 37 CFR 1.136(a) only if the non-compliant amendment is a non-final amendment or an amendment filed in response to a *Quayle* action.

Failure to timely respond to this notice will result in:

Abandonment of the application if the non-compliant amendment is a non-final amendment or an amendment filed in response to a *Quayle* action; or

Non-entry of the amendment if the non-compliant amendment is a preliminary amendment or supplemental amendment.

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1. The proposed amendments to claims 1 and 5, adding the limitation that the "melting point of at least one of said plurality of wax components . . . is set in a range of 50°C to 120°C . . ." (emphasis added), raise new issues because said limitation was not present in the claims when the final rejection was mailed on Jul. 13, 2005. Claim 2, which depended from claim 1, at the time the final rejection was mailed, recited that the "melting point of the wax . . . is set in a range of 50°C to 120°C . . ." (emphasis added). The term "the wax" recited in claim 2 refers to "a wax comprising a plurality of wax components" recited in claim 1. In other words, claim 2 required that the wax, which is a mixture of wax components, has a melting point in the range of 50°C to 120°C, not a wax component of the mixture as recited in the proposed-amended claims 1 and 5.

The proposed amendment to claim 5, adding the phrase "a developing unit for developing the electrostatic image, using an electrostatic charge image developing toner" (emphasis added), also raises new issues because the apparatus no longer requires the toner recited in claim 5. Claim 5, at the time of the final rejection, recited that the image forming apparatus comprises "an electrostatic charge image developing toner." The proposed amendment to claim 5 would reinstate the rejection under 35

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U.S.C. 102(b) over US 6,447,968 B1 (Ohno'968) set forth in the office action mailed on Sep. 22, 2004, paragraph 10.

The proposed amendment to claim 3, adding the limitation that "at least one of said plurality of wax components comprises a crystallinity which is greater than 85% and less than 93%" (emphasis added), raises new issues because said limitation was not present in the claims when the final rejection was mailed on Jul. 13, 2005. The previously filed claim 3, which depended from claim 1, at the time the final rejection was mailed, recited that the "the wax comprises a crystallinity which is greater than 85% and less than 93%" (emphasis added). The term "the wax" recited in claim 3 refers to "a wax comprising a plurality of wax components." In other words, claim 3 recited that the wax, which is a mixture of wax components, comprises the particular crystallinity, not a wax component as recited in the proposed-amended claim 3.

The proposed amendments to claims 6 and 7, adding the limitations that the "wax is present in an amount 0.5 wt% to 10 wt% [claim 7: 3.0 wt% to 6.0 wt%] with respect to a total amount of said fixing resin and said wax," (emphasis added) raise new issues because said limitations were not present in the claims when the final rejection was mailed on Jul. 13, 2005. The previously filed claims 6 and 7, at the time the final

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rejection was mailed, recited that the "wax comprises 0.5 wt% to 10 wt% [claim 7: 3 wt% to 6.0 wt%] of the electrostatic charge image developing toner" (emphasis added). In other words, claims 6 and 7 recited that the amount of wax recited in those claims was based on the total weight of the toner, not on the total weight of the fixing resin and wax as recited in the proposed-amended claims 6 and 7.

The proposed amendment to claim 15, adding the limitation that the wax comprises a rationalized molecular weight distribution "by including an appropriate amount of low molecular weight wax in said wax," raises new issues because said limitation "by including an appropriate amount of low molecular weight wax" was not present in the claims when the final rejection was mailed on Jul. 13, 2005.

2. Notice of NON-COMPLIANT AMENDMENT (37 CFR 1.121)

Item C: The proposed "Amendment to the specification" section filed on Nov. 10, 2005, is not in compliance with 37 CFR 1.121, because the proposed amended paragraph at page 26, line 7, attempts to amend a paragraph that is not present in the instant specification.

The proposed amended paragraph attempts to delete the term "Teflon." That term was deleted in the previously filed amended

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paragraphs in the "Amendment to the specification" section filed on Apr. 14, 2005.

37 CFR 1.121(b)(1)(ii) states that "[t]he full text of any replacement paragraph with markings to show all the changes relative to the previous version of the paragraph. The text of any added subject matter must be shown by underlining the added text. The text of any deleted matter must be shown by strike-through except that double brackets placed before and after the deleted characters may be used to show deletion of five or fewer consecutive characters . . ." (emphasis added).

3. The examiner's refusal to enter the amendment filed on Nov. 10, 2005, renders applicants' arguments moot regarding said amendment. The rejections of instant claims 1-15, 18, and 19 stand for the reasons discussed in the final rejection mailed on Jul. 13, 2005.

Regarding the objection to the specification under 35 U.S.C. 132(a), applicants further assert that the amendment changing the fixing resin amount from "85 wt%" to -- 84 wt% -- merely corrected an apparent typographic error. Applicants' comments are not persuasive. As discussed in the objection in the final rejection mailed on Jul. 13, 2005, the toner comprises five toner components at particular amounts. There is nothing in the originally filed specification to indicate that the typographic error was in the fixing resin amount of "85 wt%," and not in the amounts of one or more of the other four remaining toner components.

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Regarding the rejections of claims 9-13 under 35 U.S.C. 112, second paragraph, applicants assert that the phrase "at least one" is definite. However, applicants have not addressed the rejections. The examiner did not state that the phrase "comprises at least one" was indefinite. Claims 9 to 13 recite the phrase at least one of . . . and . . . " (emphasis added). It is not clear whether the claims require only one of the components recited in the list of components or all of the recited components. For example, does claim 9 require that the natural wax comprise an animal wax, a mineral wax, or a petroleum wax or that the natural wax comprises an animal wax, mineral wax, and a petroleum wax? The examiner requests clarification to what the claim language "comprises at least one of . . . and . . ." refers.

Regarding the rejections of claims 8-10 and 13 under 35 U.S.C. 112, first paragraph, applicants' arguments are not persuasive for the reasons of record discussed in the final rejection, paragraph 12, items (5) and (6), respectively. Furthermore, there is no general disclosure in the originally filed specification of the combination of the waxes as broadly recited in instant claims 8-10. Nor is there any general disclosure in the originally filed specification for the alpha olefin broadly recited in instant claim 13. The examples in the

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specification only provide an adequate written description for those particular wax mixtures exemplified or particular waxes exemplified in the examples.

Regarding the rejections over Onuma and the rejections over Bartel, because of the examiner's refusal to enter the amendment filed on Nov. 10, 2005, applicants' arguments regarding said amendment are moot. Furthermore, applicants' comments that Onuma's one example of the wax melting temperature in the range of 50 to 120°C recited in claim 2 does "not provide a range for the wax melting temperature" (emphasis in the original) is not persuasive. As set forth in the final rejection, paragraph 16, claims 1, 2, 5, 6, 8, 9, and 11-13 are rejected under 35 U.S.C. 102(b) over Onuma. Because Onuma teaches that its mixture of waxes has a melting point within the range recited in claim 2, that melting point anticipates the melting point range recited in claim 2. "A specific example in the prior art which is within a claimed range anticipates the range." MPEP 2131.03 (8th edition, Rev. 3, Aug. 2005). Moreover, applicants' assertion that the rejection under 35 U.S.C. 102(e) over Bartel is not proper because a single reference was not used is not found persuasive. A "35 U.S.C. 102 rejection over multiple references has been held to be proper when the extra references are cited to . . . explain the meaning of a term used in the

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reference . . . or . . . show that a characteristic not disclosed in the reference is inherent." MPEP 2131.01. In the instant rejection, Fields is cited to show that POLYWAX 1000 used in the Bartel mixture of waxes inherently has an onset temperature in a DSC curve of 65.1°C. Sacripante is cited to show that POLYWAX 725 used in the Bartel mixture of waxes inherently has an onset temperature in a DSC curve of about 80°C. Thus, the citations of Fields and Sacripante are proper, and for the reasons discussed in the rejection, the Bartel mixture of waxes satisfies the relationships in formulas (1) and (2) recited in claim 1. Accordingly, Bartel teaches every limitation recited in instant claim 1, and the rejection over Bartel stands.

Applicants' traversal in the reply filed on Nov. 10, 2005, of the restriction requirement that was necessitated by the addition of claims 16 and 17 filed in the amendment on Apr. 14, 2004, is on the grounds that searches for the toner in Group I and the wax in Group II "would be coextensive, such that there would be no additional searching burden placed on the PTO if the examination of the Group I [toner] and Group II [wax] was conducted in the same application."

This not found persuasive. As set forth in the restriction requirement, the examiner has provided reasons as to why the

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toner in Group I is patentably distinct from the wax in Group II. Applicants have not specifically indicated the errors in the restriction or specifically articulated why the reasons for restriction are inadequate. In addition, applicants have not provided any reasons why the toner in Group I and the wax in Group II are not patentably distinct, or stated on the record that the inventions of the two groups are obvious variations of each other.

Moreover, as set forth in the restriction requirement, the search for the toner in Group I and the search for the wax in Group II are not co-extensive. A search for the wax does not require a search in the toner composition subclass 430/108.4+ and the image forming apparatus subclass 399/252. Nor does a search for the toner in Group I require a search in the wax subclass 106/270. The distinct searches and the distinct issues of patentability establish the burden on the Office.

The requirement is still deemed proper and is therefore made FINAL.